



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,450	11/12/2003	Scott William Rosencrance	09328.105084 US	7997

7590 03/03/2005

Madeline I. Johnston, Esq.
KING & SPALDING LLP
45th Floor
191 Peachtree Street, N.E.
Atlanta, GA 30303

EXAMINER

ALVO, MARC S

ART UNIT	PAPER NUMBER
----------	--------------

1731

DATE MAILED: 03/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/706,450

Applicant(s)

ROSENCRANCE ET AL

Examiner

Steve Alvo

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-80 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-11, 14-27, 60, 62-64 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over BORCHARDT et al (5,227,019).

BORCHARDT et al teaches converting waste paper to a low alkaline (column 7, lines 61-68) or non-alkaline pH (column 8, lines 37-46, e.g. pH 7.0); contacting the slurry with BORCHARDT et al ethoxylated alcohols (columns 3 and 4) including EO-PO straight chained and branched (column 5, lines 29-47) ethoxylated alcohols (column 6, lines 36-44, lines 55-58 and TABLE I) having 8 to 18 carbon atoms (column 6, lines 27-36) and an alkoxyated or non-alkoxyated fatty acid having 8 to 18 carbon atoms (column 7, lines 1-28) and separating the ink by flotation and washing (claim 1 of BORCHARDT et al). Any difference would have been an obvious modification of BORCHARDT et al. See Example 3 for a mixture of ethoxylated alcohols. See column 7, line 68 for adding sodium silicate. See column 8, lines 14-21 for a temperature of at least 22 °C. If not taught by BORCHARDT the ratios of fatty acid to ethoxylated alcohol would have been obvious from the teachings of BORCHARDT et al.

Claims 29, 30, 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over BORCHARDT et al (5,227,019) as applied to claim 1 above, and further in view of WO 93/22491.

WO 93/22491 teaches using $R-C(O)O-[(CH_2-CH_2-O)-(CH-CH(3)-O)]-H$ fatty acids to deink pulp. It would have been obvious to use the fatty acid of WO 93/22491 for the fatty acid of BORCHARDT et al as they perform the same function of aiding in the deinking of wastepaper (see WO 93/22491, page 2, lines 16-24).

Claims 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over BORCHARDT et al (5,227,019) as applied to claim 1 above, and further in view of ROBINSON et al (6,544,383).

ROBINSON et al teaches that tall oil can be used as a fatty acid deinking agent (column 6, line 24) and as an alternative to fatty acid coconut oil. It would have been obvious to substitute the tall oil of ROBINSON et al for the fatty acid coconut oil of BORCHARDT et al as their alternativeness as deinking agents is taught by ROBINSON et al.

Claims 12-13, 31-47, 50-59, 65, 67-77, 79 and 80 are rejected under 35 U.S.C. 103(a) as being unpatentable over BORCHARDT et al (5,227,019) as applied to claim 1 above, and further in view of ADMITTED PRIOR ART (Specification, page 18, lines 14-17).

The ADMITTED PRIOR ART teaches that cationic polymers are known flotation additives. It would have been obvious to add the known flotation additives of the ADMITTED PRIOR ART, in the flotation stage of BORCHARDT et al, for their known function of aiding the deinking of recycle paper during the flotation stage.

Application/Control Number:
10/706,450
Art Unit: 1731


Page 4

Claims 48 and 49, 66, 78 are rejected under 35 U.S.C. 103(a) as being unpatentable over BORCHARDT et al 5,227,019) in view of ADMITTED PRIOR ART (Specification, page 18, lines 14-17) as applied to claim 31 above, and further in view of ROBINSON et al (6,544,383).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Alvo whose telephone number is 571-272-1185. The examiner can normally be reached on 5:45 AM - 2:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steve Alvo
Primary Examiner
Art Unit 1731

msa